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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,642	12/29/1999	THOMAS J. FOTH	E-978	2513

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PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/474,642

Applicant(s)

FOTH, THOMAS J.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 14, 2003 has been entered.

Response to Arguments

2) Applicant's arguments, filed October 14, 2003, with respect to the rejection under 35 USC 112, 2nd paragraph have been fully considered but they are not persuasive.

-- Because the patent system is based on *quid pro quo*, the applicant must particularly point out and distinctly claim the subject matter such that one skilled in the art would know how to make and use the invention. Accordingly, the examiner respectfully disagrees to applicant's argument that any person having a skill in the art could make and use the invention by setting up the refund account and it is not relevant to patentability. Although the applicant seeks to clearly define who is setting up the account ("the dispute account can be set by the 'Post Office'..."), it is still deemed to be unclear who MUST set up the account because any user can abuse the system by requesting the refund without the process of authenticated by the Post Office. The applicant asserts that such loss would be limited by the threshold value and would be

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acceptable by the post office. However, the applicant fails to handle the potential abuses by thousands of users. Since the current claims do not point out who sets up the account, they are still deemed to be unclear whether the applicant's postage metering system actually refunds the spoiled postage amount from the Post Office, or diverts the fund from the additional private account (called a dispute account), which is associated with a corresponding one of the user accounts, to user.

3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action

Claim Rejections - 35 USC § 101

4) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5) Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The computer program itself cannot be directed to a practical application of the invention in the useful art to accomplish a concrete, useful, and tangible result. When the computer program is actually executed by the computer, the claimed subject matter produces a useful, concrete and tangible result.

Claim Rejections - 35 USC § 112

6) Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1, 7, 17 and 20, respectively, the recitation of "refunds" renders the claim indefinite and vague because of the reasons as cited above. The claims, themselves, are silent whether the Applicant's postage metering system actually refunds the spoiled postage amount from the Post Office, or diverts the fund from the additional private account (called a dispute account), which is associated with a corresponding one of the user accounts, to user. If the dispute account were set up by the user (not by the Post Office), the reimburse process could not constitute the **refund** because the user got his/her money back from his/her other account, not from the Post Office. If the Post Office set up the dispute account, any user could abuse the system by requesting the refund without the process of authenticated by the Post Office. Accordingly, the Applicant particularly fails to point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

7) Claims 1-4, 7-8 and 10-21, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis et al. (US 6,233,565).

W.R.T. Claim 1:

Lewis et al. discloses a method comprising the steps of :

receiving at a computer a refund request (see Table I; col. 3, line 57 – col. 4, line 6; col. 13, lines 3-16; col. 17, lines 42-67; col. 31, line 50 – col. 32, line 4);

using the computer for accessing a dispute account database for identifying a dispute account having a value therein that is indicative of a level of refund activity attributable to the postage meter, the dispute account being associated with the request (see Id.);

determining if the value in the dispute account is acceptable for permitting a refund; and

refunding the postage amount to a user of the postage meter.

Lewis et al. further discloses the method including:

W.R.T. Claim 2: sending enabling data from the computer to the postage meter, the enabling data useable by the postage meter to add the postage amount to a vault of the postage meter to effectuate the refunding of the postage amount (see Supra);

W.R.T. Claim 3: adjusting the value in the dispute account to account for the postage amount refunded;

W.R.T. Claim 4: sending funds equivalent to the postage amount to a user identified account (e.g. credit card account);

W.R.T. Claim 11: sending the request from the postage meter to the computer;

W.R.T. Claim 12: wherein the postage meter is remotely located from the computer (see Supra);

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W.R.T. Claim 13: maintaining a transaction record of the refunding at the computer (see Id.); and

W.R.T. Claim 14: wherein the postage amount correlates to a postage value previously dispensed by the postage meter.

W.R.T. Claim 10: Lewis et al. discloses a computer medium, when executed by a processor, for performing the steps of Claim 1:

W.R.T. Claims 7 and 20:

Lewis et al discloses a postage metering system comprising:

a postage meter having a vault that accounts for postage dispensed by the postage meter (see Table I; col. 3, line 57 – col. 4, line 6; col. 13, lines 3-16; col. 17, lines 42-67; col. 31, line 50 – col. 32, line 4);

a processor;

a data center in communication with the postage meter, the data center having a CPU and a dispute account database, the dispute account database having a dispute account having a value there that is indicative of a level of refund activity attributable to the postage meter, the dispute account being associated with the postage meter;

means for permitting communication between the postage meter and the data center; and

wherein the secure CPU determines a refund of postage.

Lewis et al. further discloses the system including:

W.R.T. Claims 8 and 21: wherein the CPU sends enabling data from the computer to the postage meter, the enabling data useable by the postage meter to add the postage amount to a vault of the postage meter (see Supra);

W.R.T. Claim 15: wherein the postage meter sends the request to the data center and the postage amount correlates to a postage value previously dispensed by the postage meter (see Id.); and

W.R.T. Claim 16: wherein the postage meter is remotely located from the data center.

W.R.T. Claim 17:

Lewis et al. discloses a method comprising the steps of:

receiving at a computer a refund request (see Table I; col. 3, line 57 – col. 4, line 6; col. 13, lines 3-16; col. 17, lines 42-67; col. 31, line 50 – col. 32, line 4);

accessing a dispute account database for identifying a dispute account having a value therein that is indicative of a level of refund activity attributable to the postage meter, the dispute account being associated with the request (see Id.);

determining if the value in the dispute account is acceptable for permitting a refund; and

refunding the postage amount to a user of the postage meter.

Lewis et al. further discloses the method including:

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W.R.T. Claim 18: refunding the postage amount by adding the postage amount to a vault of the postage meter; and

W.R.T. Claim 19: wherein at times when the postage meter communicates with a remote data center sending a message from the postage meter to the data center to initiate the refunding of the postage amount to the user (see Supra).

Claim Rejections - 35 USC § 103

8) Claims 5-6, and 9, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al..

Lewis et al. discloses the invention as cited above, but does not expressly disclose the invention including the limitations in Claims 5-5 and 9.

As long as the Post Office can authenticate whether the user has a compelling reason for the refund and the user has a valid account, any user's account is acceptable for permitting the refund of the postage amount. The difference, whether refunding the money to user by the electronic means (via the account) or mailing, would not be distinguished from the prior art in terms of patentability.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to mail refunds equivalent to the postage amount to the user (because mailing the refund to the user does not patentably distinguish the claimed invention), and to send a message for one of printing and display at the postage meter, the message advising that the request for a refund has been denied, for

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the purpose of refunding the money equivalent to the postage amount to the user and notifying the message (no refund) to the customer.

Regarding the Claim 9, Lewis et al. discloses the invention as cited earlier, but does not expressively disclose the postage metering system having the printing device printing a receipt of the postage amount refunded.

It is well known in any art of retailing business to print the receipt for the record of refunding by the request of the customer (or the user).

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to print the receipt of the postage amount refunded because printing the receipt for the user does not patentably distinguish the claimed invention.

Conclusion

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for

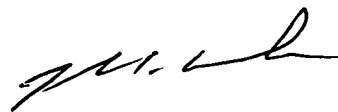
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the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
March 5, 2004



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600